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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/620,525	07/20/2000	Bruce E. Novich	1596C4	2888

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EXAMINER
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GRAY, JILL M

ART UNIT	PAPER NUMBER
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1774

DATE MAILED: 06/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/620,525

Applicant(s)

NOVICH ET AL.

Examiner

Jill M. Gray

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 28 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,5-8,13,14 and 18-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,5-8,13,14 and 18-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 4/19/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on March 28, 2005 has been entered.

### ***Response to Amendment***

The rejection of claims 1, 4-8, 13-14, and 18-32 has been withdrawn in view of applicants' arguments.

### ***Claim Rejections - 35 USC § 102***

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 5-7, 13-14, 18-21, 23-27, and 29-30 are rejected under 35 U.S.C. 102(b) as being anticipated by Afzali-Ardakani et al, 5,527,838 (hereinafter Afzali-Ardakani).

Afzali-Ardakani teaches a fabric comprising at least one strand comprising a plurality of fibers having a resin compatible coating composition on at least a portion of a surface of the fabric, wherein the at least one fiber strand comprises at least one glass .

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fiber, said resin compatible coating comprising a plurality of discrete particles, at least one lubricious material different from the plurality of discrete particles (fluorine-containing polymer) and at least one film forming material, essentially as claimed in present claims 1 and 5. See claims 1, 10, and 12 of Afzali-Ardakani. In addition, Afzali-Ardakani teaches that his plurality of glass fibers can be E-glass fibers as required by claims 6-7 and that his discrete particles can be lamellar particles such as boron nitride, per claims 13-14. See column 11, lines 1-3 and column 13, lines 35-47. Regarding claim 18, since the prior art teaches a composition that is substantially the same as that contemplated by applicants, said composition being coated on a similar fibrous substrate, the examiner has reason to believe that the plurality of particles of the prior art provide an interstitial space between at least one fiber and at least one adjacent fiber of the prior art fabric. As to claims 19-21, Afzali-Ardakani teaches that a plurality of discrete particles having a particle size of about 5 microns can be added in amounts ranging from between about 25 and 65 volume percent, which necessarily embraces applicants' claimed range. See column 11, lines 29-35, Example 7, and claim 54. As to claims 23-24, Example 4 of Afzali-Ardakani teaches amounts of the lubricious within the present claimed range. Furthermore, Afzali-Ardakani teaches that his composition contains a film forming material of the type set forth by applicants in claims 25-27, such as epoxy. See column 9, lines 15-17. As to the coating being a powdered coating composition, applicants' claims are drawn to a final product. Presumably the coating on the end product would have some degree of powdery residue.

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Accordingly, the prior art teachings of Afzali-Ardakani anticipate the invention as claimed in present claims 1, 5-7, 13-14, 18-21, 23-27, and 29-30.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 5, 13-14, and 18-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kotera et al, 4,340,519 (Kotera) in view of Puppini 6,346,160 B1.

Kotera is as applied previously and teaches a composition of the type contemplated by applicants that can be coated onto substrates such as glass and used in the formation of windows, but does not specifically teach coating his composition on a fabric comprising at least one strand comprising a plurality of fibers, wherein the at least one fiber strand comprises at least one glass fiber. Puppini teaches a thermoplastic resin and fiberglass composite comprising a continuous glass fiber fabric and compatible resin such as polyester. See abstract, column 4, lines 49-52, column 5, lines 25-26, columns 8 and 9. In addition, Puppini teaches that his composite is used in the formation of components such as windows. See column 3, lines 32-45, column 4, lines 4-8, column 11, and lines 50-56. The formation of windows using glass, and more specifically, glass fabric, is known in this art as evidenced by the teachings of Puppini. Though Kotera may be silent as to a glass "fabric" in his teaching of coating his composition on glass and its suitability for windows, it would have been obvious to one

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of ordinary skill in this art, at the time the invention was made, to use a fabric comprising at least one strand that comprises at least one glass fiber, motivated by the teachings of Puppin and the reasonable expectation of obtaining a window having a good coefficient of thermal expansion, high tensile strength and high modulus.

Therefore, the combined teachings of Kotera and Puppin would have rendered obvious the invention as claimed in present claims 1, 5, 13-14, and 18-32.

### ***Double Patenting***

6. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

7. Claims 1, 5-8, 13-14 and 18-32 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 3, 5-8, 13-14, 18-32, 44, 46-47, and 50 of copending Application No. 09/620,526. Although the conflicting claims are not identical, they are not patentably distinct from each other because coated strands of each application are substantially the same and it would have been an obvious variant to the skilled artisan to form the coated fiber strand of the copending application into a fabric as presently claimed.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Response to Arguments***

8. Applicant's arguments with respect to claims 1, 5-8, 13-14, 18-32 have been considered but are moot in view of the new ground(s) of rejection.

No claims are allowed.

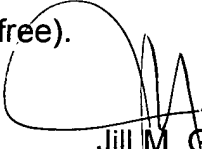
### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jill M. Gray whose telephone number is 571-272-1524. The examiner can normally be reached on M-Th and alternate Fridays 10:30-7:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rena Dye can be reached on 571-272-3186. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jill M. Gray  
Examiner  
Art Unit 1774

jmg